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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,071	08/06/2001	Michael J. Sullivan	174-956	1486
23517	7590	06/03/2004	EXAMINER	
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP			GORDON, RAEANN	
3000 K STREET, NW			ART UNIT	
BOX IP			PAPER NUMBER	
WASHINGTON, DC 20007			3711	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/923,071	<b>Applicant(s)</b> SULLIVAN, MICHAEL J.	
	<b>Examiner</b> Raeann Gorden	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,10,12,13,16,17 and 23-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5,6,8,10,12,13,16,17 and 35 is/are allowed.
- 6) ☒ Claim(s) 2,7,23-26,28-31,33 and 34 is/are rejected.
- 7) ☒ Claim(s) 27 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2, the staged resin is defined the previous claim, is this an additional material in the film? Claim 7 does not indicate a base claim

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-26, 29-31, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimosaka et al (5,730,665). Regarding claim 23, Shimosaka discloses a golf ball comprising a core and a multi-layer cover. The remaining limitations are method steps and are not relevant to the final product. Regarding claim 24, process of curing and the hardness relative to different stages of the curing are method steps and not relevant to the final product. Regarding claim 25, a layer is disposed between the film layer and the core, layer 3 (see fig 1). Regarding claim 26, the film may be made

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from polyurethane, silicone, or epoxy (col. 3, lines 55-62). Regarding claim 29, the intermediate layer of the cover is formed from single or plural layers of a laminate film (abstract). Regarding claim 30, Shimosaka discloses a golf ball comprising a core and a multi-layer cover. The intermediate layer of the cover is formed from single or plural layers of a laminate film (abstract). The film has a thickness from 50 to 400 um or 0.05 to 0.4 mm (col. 3, line 64). The process of curing and the hardness and tensile strength relative to different stages of the curing are method steps and not relevant to the final product. Regarding claim 31, the film may be made from polyurethane, silicone, or epoxy (col. 3, lines 55-62). Regarding claim 34, the film has a thickness from 50 to 400 um or 0.05 to 0.4 mm (col. 3, line 64).

Claims 28, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimosaka et al (5,730,665) in view of Sullivan (6,015,356) Shimosaka discloses the invention as shown above but does not disclose fillers in the intermediate cover layer. However, Sullivan teaches fillers in a cover intermediate layer. One skilled in the art would have included fillers in the layer to achieve the desired weight of the golf ball (see Sullivan abstract).

#### ***Allowable Subject Matter***

Claims 27 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 1, 5, 6, 8, 10, 12-13, 16, 17 are allowed

### ***Response to Arguments***

Applicant's arguments filed 3-18-04 are not persuasive. Applicant argues the partially cured resin limits the layer. Applicant also states the partially cured resin remains sticky or tacky. However, the properties/characteristics of the partially cured resin are not defined in the specification and therefore can not be assumed to be inherent features of "staged resin".

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Raeann Gorden  
Primary Examiner  
Art Unit 3711

rg  
June 1, 2004